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Patent Docket P1065R1C2

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of Gregory S. Blank Serial No.: 09/964,216 Filed: September 26, 2001 For: PROTEIN PURIFICATION	Group Art Unit: 1644 Examiner: David Saunders Confirmation No. 2025 Customer No. 09157 Express Mail No. EV 351 925 082 US November <u>17</u> , 2003 <i>Wm Lee</i> Wendy M. Lee
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APPLICATION FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 35 U.S.C.  
§ 154(b)

Mail Stop **Petitions**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

As provided by 37 C.F.R. § 1.705(b), applicant submits this application for reconsideration of patent term adjustment under 35 U.S.C. § 154(b).

Please charge the fee of \$200 required for this application, as specified in § 1.18(e), to our Deposit Account no. 07-0630.

**Statement of Facts**

1. A Notice of Allowance in the captioned application was mailed on September 29, 2003. The issue fee has not yet been paid.
2. The Notice indicated a Patent Term Adjustment (PTA) of 29 days. The correct PTA is 58 days. The error in the Office's calculation appears to result from a duplicate PALM entry on September 23, 2003, for a terminal disclaimer that was filed and noted in PALM on August 25, 2003, concurrently with a complete reply to the then-outstanding Office action. The interval between August 25 and September 23 led to an additional "applicant delay" of 29 days.
3. Only a single terminal disclaimer (i.e., the disclaimer filed on August 25, 2003) has been filed in the instant application. PALM (PAIR) indicates that the disclaimer was approved on September 4, 2003, and the Notice of Allowability, mailed September 29, 2003, refers to that terminal disclaimer by date. A second PALM entry indicating "Terminal Disclaimer Filed" appears on September 23, 2003, but no second terminal disclaimer was in fact filed.

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4. The total "USPTO delay" in the prosecution of this application is correctly calculated as follows:

Days exceeding 14 months from application filing date (September 26, 2001) to mailing of first communication under 35 U.S.C. § 132 (March 25, 2003) (§ 1.703(a)(1))	119 days
Total term adjustment (§ 1.703)(f))	119 days

5. The total "applicant delay" in the prosecution of this application is correctly calculated as follows:

Days exceeding 3 months from the mailing date of an Office action (March 25, 2003) to the date of submission of a complete response (August 25, 2003) (§ 1.704(b))	61 days
Total reduction in term adjustment (§ 1.704(a))	61 days

No interval other than the one indicated constitutes a failure by the applicant to engage in reasonable efforts to conclude processing or examination of the application within the meaning of § 1.704.

6. In view of the above, the PTA for this application is correctly determined to be (119 days) - (61 days) = 58 days.

7. The instant patent application is subject to a terminal disclaimer. By operation of the disclaimer filed on August 25, 2003, the term of a patent issuing on this application subsequent to the expiration of the full statutory term of U.S. Patent No. 6,333,398, as then shortened by terminal disclaimer,<sup>1</sup> has been disclaimed, subject to reservations for the expiration of that patent for failure to pay maintenance fees, a holding of unenforceability, finding of invalidity, statutory disclaimer, subsequent terminal disclaimer, or other premature termination.

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<sup>1</sup> U.S. Patent No. 6,333,398, issued on the immediate parent of this application, was filed on June 6, 2000, and claims priority under § 120 to U.S. Patent No. 6,127,526, filed on November 20, 1997. All claim priority under § 119(e) to prior provisional application 60/031,500, filed November 27, 1996. The '398 patent is also subject to a terminal disclaimer.

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**Relief Requested**

The Director is requested to determine that a patent granted on this application is subject to a total Patent Term Adjustment under 35 U.S.C. § 154(b) of 58 days, subject to the limitation imposed by 37 C.F.R. § 1.703(d) based on the terminal disclaimer recorded in this application.

Respectfully submitted,  
GENENTECH, INC.

Date: November 17, 2003

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